

REMARKS

In the outstanding official action, the abstract of the disclosure was objected to because of the use of the words "includes" and "comprises". In response, the original abstract is herewith cancelled, and a new abstract, in which the words "includes" and "comprises" are not used. It is respectfully submitted that the new abstract overcomes the objections noted in the Action.

Claims 1 and 12 were objected to because the use of the phrase "and/or" was deemed to render the claims unclear with regard to which limitations are part of the claimed invention. In response, claims 1 and 12 are herewith amended in order to recite the intended subject matter in a clear and definite manner, thus overcoming the objections contained in the Action.

On the merits, claims 1-8 and 12-13 were rejected under 35 USC 103(a) as being unpatentable over Berge et al in view of Borra et al, with the remaining dependent claims being rejected under §103 (a) as being unpatentable over the foregoing references in view of the additional cited and applied art, all for the reasons of record.

In response to the foregoing rejections, it is respectfully submitted that independent claims 1 and 12, as herewith amended, and the remaining claims depending therefrom, are clearly patentably distinguishable over the cited and applied art for the

reasons detailed below.

In the Action, it is suggested that Berge and Borra are properly combinable because they are related as variable optical devices. In response, it is respectfully submitted that, on the contrary, these references are related to substantially different devices such that one of ordinary skill in the art would find no reason to combine their teachings absent the benefit of impermissible hindsight derived from the instant disclosure.

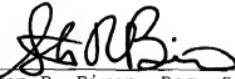
Thus, whereas Berge is directed to a very small variable focus lens having a size between several tens of micrometers and several tens of millimeters, for use in particular in the field of optoelectronic systems or endoscopy (see, for example, col. 7, lines 12-16), the Borra reference is directed to "large mirrors" for use in telescopes. Clearly, both the substantially different dimensions of the two prior-art structures and the diverse fields in which they are incorporated make it very clear that there would be no apparent reason to combine these teachings absent the benefit of impermissible hindsight. Put another way, no one of ordinary skill in the art at the time the instant invention was made would consider incorporating mirror technology for a large telescope mirror into a minute variable focus lens intended for use in optoelectronic systems or endoscopy.

Furthermore, even assuming *arguendo*, that the references were to be combined, the theoretical construction discussed in Borra is

in fact stated to be "a hybrid between a liquid mirror and a solid metal-coated mirror" (last column, lines 13-15). Thus, not only is there no apparent reason to incorporate the large telescope mirror technology of Borra into the very small variable focus lens for use in opto-electronics systems or endoscopy of Berge, but such a suggested combination still would neither show nor suggest the instant invention as now more precisely claimed, since Borra expressly states that his mirror is really a hybrid liquid-solid metal coated mirror rather than a mirror formed at the interface of two fluids.

In view of the foregoing amendments and remarks, it is respectfully submitted that the instant application is now in proper form, and that independent claims 1 and 12, as herewith amended, and the remaining claims depending therefrom, are clearly patentably distinguishable over the cited and applied references. Accordingly, allowance of the instant application is respectfully submitted to be justified at the present time, and favorable consideration is earnestly solicited.

Respectfully submitted,

By 
Steven R. Biren, Reg. 26,236
Attorney
(914) 333-9630